



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,746	10/29/2003	Dan Coppus	RANPP0346USA	6320
23908	7590	12/23/2005		
RENNER OTTO BOISSELLE & SKLAR, LLP 1621 EUCLID AVENUE NINETEENTH FLOOR CLEVELAND, OH 44115			EXAMINER HARMON, CHRISTOPHER R	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

TW

Office Action Summary	Application No. 10/696,746	Applicant(s) COPPUS ET AL.	
	Examiner Christopher R. Harmon	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 24-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 29-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 24-28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/10/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. The amendment to claim 18 presents new claims (not previously considered). Claims 18-23 are treated on the merits, however newly submitted claims 24-28 are directed to inventions that are independent or distinct from the invention originally claimed for the following reasons:

The originally claimed invention was directed towards a conversion machine with a fan-folded supply comprising a cart and/or a pallet of figures 1-10. This application contains claims directed to the following patentably distinct species of the claimed invention:

Claims 24-27 are directed towards an inclined supply tray support of figures 17-18.

Claim 28 is directed towards an elevator support device of figure 19.

Currently, claim 19 is generic.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 24-28 are withdrawn from consideration as being directed to non-elected inventions. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 18-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 18, it is unclear as to how the stacked supply includes a "continuous ply" (ie. there is a beginning/end to the stacks). Furthermore, it is unclear as to how the pages "piled accordion style one on top the other" form multiple stacks (ie. pages would form a single stack).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 10-14, 16, 18-20 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Simmons, Jr. (US 5,387,173).

Simmons, Jr. discloses a conversion system comprising a dunnage converter 54 with upright and transverse members 36 and fan folded stock material; see figure 1. Simmons, Jr. provides for palletizing boxes of fan folded stock material for conversion (see column 5, lines 18-22). Given the dimensions of the boxes 20 "palletizing" the stock material includes multiple boxes stacked horizontally and vertically and a system

with two or more stacks of fan folded stock material are provided with a portable support device; i.e. a pallet.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5, 8-16, and 29-32 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ratzel (US 5,823,936).

Ratzel discloses a dunnage converter with a supply of stock material as taught by Simmons, Jr. in US 5,387,173; see above and column 5, lines 21-23. Ratzel discloses the use of a cart for positioning the stock supply; see column 7, lines 22-26. It is not clear as to the specific teaching of Ratzel of supplying the fan stock supply to the converter, however given the disclosure of palletizing multiple stacks (in boxes 20) of fan stock material for use in the dunnage converter the loading of the converter would incorporate positioning the stacks proximate the converter for conversion. At least it would have been obvious to one of ordinary skill in the art at the time the invention was made to position two or more stacks proximate the converter before feeding them to the converter sequentially in order to convert a needed amount of dunnage.

8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simmons, Jr. (US 5,387,173).

Simmons, Jr. does not directly disclose the transverse member of the support as moveable to height above the stacks, however does state that the fan-folded stock material is compatible with the conversion machine of US patent application #07/712,203 (see column 6, line 59) now US patent #5,123,889. The conversion machine in patent '889 clearly shows dunnage conversion machines 20 mounted on transverse member 336 connected to transversely spaced upright members 332 at the ends by slide member 334; see figures 13 and 14. Given that the transverse member of Simmons, Jr. may interfere with the varying heights of stacks being fed to the converter, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide for adjustable heights of the transverse member as provided by Armington et al. and incorporated by reference in the invention of Simmons, Jr. since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. See also, *In re Stevens*, 101 USPQ 284 (CCPA 1954).

9. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ratzel as applied to claims 1-5, 8-16, and 29-32 above and further in view of Harding (US 6,756,096).

Ratzel does not directly disclose loading on the support device without interrupting the dunnage converter however Harding teaches splicing fan folded leading end to the trailing end during a conversion process so as to prevent downtime; see

Art Unit: 3721

figure 3. At least two stacks are simultaneously conveyed to the converter of the multiplied stacks of stock material after the splicing operation. It would have been obvious to one of ordinary skill in the art to load the stock material as taught by Harding in the invention to Ratzel for providing for a continuous converting process. Note: the limitation of sequential loading without interruption (claim 6) could be interpreted as broadly as an operator placing another stack upon the support.

10. Claims 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ratzel as applied to claims 1-5, 8-16, and 29-32 above, and further in view of Simmons, Jr. et al. (US 6,095,454).

The cart of Ratzel is not fully disclosed however Simmons, Jr. et al. teaches a dunnage conversion system with a cart for supporting multiple supplies of stock material comprising upright members 92 with an inward channel which would support the stacks of stock material. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the cart of Simmons, Jr. in the invention to Ratzel for supplying multiple stacks of stock material for the conversion process.

11. Claims 18-20 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simmons, Jr. (US 5,387,173) in view of Crowley (US 6,027,298).

Simmons, Jr. does not directly disclose the configurations of the stacks either on the pallet or cart however Crowley teaches a cart 340 with pallets 350 for handling/storing stacks 348 of fan-folded paper material; see figure 22. The stacks of fan-folded paper material are vertically stacked. It would have been obvious to one of

Art Unit: 3721

ordinary skill in the art at the time the invention was made to palletize the stacks of fan-folded material according to the invention to Crowley in the invention of Simmons, Jr. in order to store the supply of conversion material.

12. Claims 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simmons, Jr. (US 5,387,173) in view of Slaters, Jr. et al. (US 6,068,125).

Simmons, Jr. does not directly disclose the configurations of the stacks on the pallet however Slaters, Jr. et al. disclose storing multiple stacks of fan-folded material 10 horizontally stacked upon pallet 27; see figure 1. It would have been obvious to one of ordinary skill in the art at the time the invention was made to palletize the stacks of fan-folded material according to the invention to Slaters, Jr. et al. in the invention of Simmons, Jr. in order to store the supply of conversion material.

Response to Arguments

13. Applicant's arguments filed 9/28/05 have been fully considered but they are not persuasive.

Regarding Simmons '173, the discussion of palletizing the fan-folded supply material is immediately preceded by "consumer information may be printed on *each* box" (emphasis added, see column 5, lines 16+). Therefore there is more than a singular box, ie. at least two boxes, comprising a stack of fan-folded material proximate to the converter. Similarly, this applies to the arguments in paragraph II of page 7 of the response.

Regarding the argument concerning adjustability see above rejection and the full disclosures of both Simmons, Jr. '173 and Armington et al. '889.

Regarding the arguments concerning Harding, the operation is considered providing a simultaneous feed ie. when spliced together.

Regarding the arguments concerning Ratzel and Simmons '454, that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Ratzel discloses the capability of using either stock rolls or fan-folded material. The cart provided by Simmons allows for easy transport of the supply material, which furthermore has adjustable height positions. The cart of Simmons would be fully capable of supporting either source of supply material.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

Art Unit: 3721

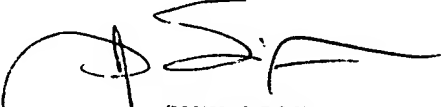
TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Harmon whose telephone number is (571) 272-4461. The examiner can normally be reached on Monday-Friday from 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ch



JOHN SIPOS
PRIMARY EXAMINER